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| | | | |
|---|-----------------------------|-------------------------------|-------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 09/464,416 | |
| | Filing Date | December 16, 1999 | |
| | First Named Inventor | Yasmin Thanavala | |
| | Group Art Unit | 1651 | |
| | Examiner Name | M. Flood | |
| Total Number of Pages in This Submission | 4 | Attorney Docket Number | RPP:156B US |

| ENCLOSURES (check all that apply) | | |
|--|--|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): |
| <div>Remarks</div> | | |

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| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--|--------------------------------------|------|-----------|
| Firm or Individual name | Michael L. Dunn Dunn & Associates | | |
| Signature | | | |
| Date | Nov. 5, 2001 | | |
| CERTIFICATE OF MAILING | | | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: Nov 5, 2001 | | | |
| Typed or printed name | Michael L. Dunn | | |
| Signature | | Date | 11/5/2001 |

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FEE TRANSMITTAL
for FY 2001

JAN 22 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$)

Complete if Known

| | |
|----------------------|-------------------|
| Application Number | 09/464,416 |
| Filing Date | December 16, 1998 |
| First Named Inventor | Yasmin Thanavala |
| Examiner Name | M. Flood |
| Group Art Unit | 1651 |
| Attorney Docket No. | RPP:156B US |

METHOD OF PAYMENT

- 1.
- ☐
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit
Account
Number

04-1790

Deposit
Account
NameCharge Any Additional Fee Required
Under 37 CFR 1.16, 1.17, 1.18 and 1.20Applicant claims small entity status.
See 37 CFR 1.27

- 2.
- ☐



Check



Credit Card



Money Order



Other

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity Fee Code | Small Entity Fee Code | Fee (\$) | Fee (\$) | Fee Description |
|--------------------------|--------------------------|----------|----------|-----------------|
|--------------------------|--------------------------|----------|----------|-----------------|

| | | | | |
|-----|-----|-----|-----|------------------------|
| 101 | 710 | 201 | 355 | Utility filing fee |
| 106 | 320 | 206 | 160 | Design filing fee |
| 107 | 490 | 207 | 245 | Plant filing fee |
| 108 | 710 | 208 | 355 | Reissue filing fee |
| 114 | 150 | 214 | 75 | Provisional filing fee |

Fee Paid

SUBTOTAL (1)

(\$)

2. EXTRA CLAIM FEES

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|----------------------|------------------------------|------------------------|------------------------|
| <input type="text"/> | -20** = <input type="text"/> | X <input type="text"/> | = <input type="text"/> |
| Independent Claims | -3** = <input type="text"/> | X <input type="text"/> | = <input type="text"/> |
| Multiple Dependent | | | |

| Large Entity Fee Code | Small Entity Fee Code | Fee (\$) | Fee (\$) | Fee Description |
|--------------------------|--------------------------|----------|----------|-----------------|
|--------------------------|--------------------------|----------|----------|-----------------|

| | | | | |
|-----|-----|-----|-----|---|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 80 | 202 | 40 | Independent claims in excess of 3 |
| 104 | 270 | 204 | 135 | Multiple dependent claim, if not paid |
| 109 | 80 | 209 | 40 | **Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | **Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2)

(\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Fee Code | Large Entity Fee (\$) | Small Entity Fee (\$) | Fee Description | Fee Paid |
|---------------------|--------------------------|--------------------------|-----------------|--|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet |
| 139 | 130 | 139 | 130 | Non-English specification |
| 147 | 2,520 | 147 | 2,520 | For filing a request for ex parte reexamination |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examination action |
| 115 | 110 | 215 | 55 | Extension for reply within first month |
| 116 | 390 | 216 | 195 | Extension for reply within second month |
| 117 | 890 | 217 | 445 | Extension for reply within third month |
| 118 | 1,390 | 218 | 695 | Extension for reply within fourth month |
| 128 | 1,890 | 228 | 945 | Extension for reply within fifth month |
| 119 | 310 | 219 | 155 | Notice of Appeal |
| 120 | 310 | 220 | 155 | Filing a brief in support of an appeal |
| 121 | 270 | 221 | 135 | Request for oral hearing |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable |
| 141 | 1,240 | 241 | 620 | Petition to revive - unintentional |
| 142 | 1,240 | 242 | 620 | Utility issue fee (or reissue) |
| 143 | 440 | 243 | 220 | Design issue fee |
| 144 | 600 | 244 | 300 | Plant issue fee |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner |
| 123 | 50 | 123 | 50 | Processing fee under 37 CFR 1.17(q) |
| 126 | 180 | 126 | 180 | Submission of Information Disclosure Stmt |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) |
| 146 | 710 | 246 | 355 | Filing a submission after final rejection (37 CFR § 1.129(a)) |
| 149 | 710 | 249 | 355 | For each additional invention to be examined (37 CFR § 1.129(b)) |
| 179 | 710 | 279 | 355 | Request for Continued Examination (RCE) |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application |
| Other fee (specify) | | | | |

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$)

SUBMITTED BY

Name (Print/Type)

Michael L. Dunn

Registration No.
(Attorney/Agent)

25,330

Complete (if applicable)

Telephone

716-433-1661

Signature

Date

11/05/01

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Yasmin Thanavala, et al.

Art Unit: 1651

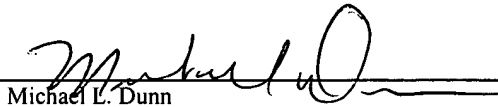
Serial No: 09/464,416

Filed: December 16, 1999

Examiner: M. Flood

For: ORAL IMMUNOLOGY USING
PLANT PRODUCT CONTAINING
CONTAINING A NON- ENTERIC
PATHOGEN ANTIGEN

I certify that this **Reply Brief** is being deposited on
November 5, 2001 with the U.S. Postal Service as first class
mail addressed to the Assistant Commissioner for Patents,
Washington, D.C. 20231


Michael L. Dunn

Registration No. 25,330

REPLY BRIEF

Box AF
Assistant Commissioner for Patents
Washington, DC 20231

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Sir:

The attorney for the Appellants considers that most arguments showing patentability of the claims have already been set forth in the Appeal Brief.

We do, however, wish to point out the Examiner's rejections are inconsistent on their face.

In attempting to support the art rejection under 35 USC 103, the Examiner on page 10 of the Answer says:

"Thus, one would have had a reasonable expectation of success to provide a therapeutic regimen such as the one in the claimed invention because the determination of an effective treatment method for providing an immune response by the oral ingestion of the claim-designated drug in combination with an orally effective adjuvant in an individual which was greater than the response elicited by the NEPA alone would have been a matter of routine optimization to one of ordinary skill in the art at the time the invention was made."

This statement (admission) is made by the Examiner based upon the Examiner's view of the cited art alone without consideration of the teachings in the current specification which is the only true teaching and suggestion of "a method for providing a specific immune response by feeding a mammal with genetically altered potato expressing a NEPA with an adjuvant", (see Examiner's Answer page 8, lines 13-16).

The Examiner's statement on page 10 of the Examiner's Answer is completely inconsistent with the statement by the Examiner on page 5 used to support the Examiner's 35 USC 112 rejection, i.e., "However, the specification does not provide sufficient guidance as to how one of ordinary skill in the art would provide an immune response in a mammal and/or a human to a NEPA other than the non-enteric pathogen antigen, hepatitis B surface antigen."

The Examiner's Answer thus says on page 10 that the state of the art alone is sufficient to reduce the claimed invention to practice as "a matter of routine optimization", but the added detail and specific teachings of the specification to the known state of the art somehow "does not provide sufficient guidance". The inconsistency is clear.

Both the 35 USC 112 and 35 USC 103 rejections should be reversed and the claims should be allowed.

Dated: November 5, 2001

MLD/cah

Respectfully submitted,



Michael L. Dunn

Attorney for Applicant(s)

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